

ARGUMENTS REGARDING THE REJECTIONS

- 1) Claims 1-3 and 25 have been rejected under 35 USC 102(b) as anticipated by Dahl, U.S. Patent No. 5,653,444.

The rejection asserts that Dahl shows each and every limitation of these claims as follows:

- a) Dahl discloses a wagering game using a standard set of cards. The four Aces and the 4-of-Clubs are replaced with replacement cards of equal count value.
- b) The replacement cards have identifying markings of "V," "E," "G," "A" and "S" as shown in Figure 2. This differentiates replacement cards from the standard Aces and 4-of-Clubs cards.
- c) The Dahl game is played by a wager on the underlying card game and optionally placing a wager on an optional side card game. (Col. 2, lines 53-55)
- d) A total of five cards are dealt to the player and to the dealer as needed to complete a poker game.
- e) The player receives bonus on the side bet wager game if the player hand contains all of the symbols or has a high ranked poker hand (whether or not the symbols are present in the hand). Certain of the high ranked hands (e.g., Four Aces and a Royal Flush) must incidentally contain four or one of the symbols, respectively. Other hands may or may not contain the symbols, and the payouts are not influenced by the presence or absence of the symbols in the hand.

Although the Examiner has correctly identified the material disclosure of Dahl, the disclosure does not anticipate the actual limitations in the claims. Claim 1 recites:

"A method of playing a wagering card game comprising an underlying card game and an auxiliary card game comprising:
providing a standard set of cards in which some cards, but less than all cards, of at least one certain count value are replaced with replacement cards of equal count value, but the replacement cards have identifying markings that differentiate replacement cards from standard spades, hearts, diamonds and clubs suits;

placing at least one wager on the underlying card game;
optionally placing a wager on the auxiliary card game;
dealing a first number of cards to a player;
dealing cards as needed in the play of the player's hand, in
common cards, the dealer's hand or combinations thereof to complete the
underlying card game;
displaying all of the player's cards;
**wherein if at least one of the displayed player's cards is a replacement
card, paying a player who has placed the optional wager for the presence
of the at least one replacement card in either the player's hand or the
dealer's hand;** and
paying a player according to the rules of the underlying game.

At least one series of limitations in claim 1 that is not disclosed by Dahl has been highlighted above. The lack of teaching of the highlighted text is multi-fold in its error. In Dahl, the player does not make an optional wager for the presence of at least one replacement card (or equivalent special symbol in claim10). In Dahl, the player is making a side bet on the appearance of specific hands, some of which may or may not incidentally have one or more of the replacement cards. For example, an Ace, 2, 3, 4 and 5 straight will have at least one replacement card and may have two replacement cards (if the 4-of-Clubs is the 4). There is no difference in payment as between the presence of one or two replacement cards. The wager is on the hand, not on the presence of at least one replacement card. Claim 1 specifically and unequivocally recites that the wager and subsequent payment is based upon the presence of at least one replacement card.

Similarly in Dahl, a Royal Flush must also have one replacement card, but the payment is not for the presence of at least one replacement card, but for the Royal Flush.

Similarly in Dahl, an Ace-5 straight flush or any straight flush having the Four-of-Clubs will have one of the replacement cards, with the Ace-5 of Clubs straight flush having two replacement cards. Again, it is the hand rank that is being wagered upon and upon which the wager is paid. The presence of only one or two of the replacement cards is not a basis for payment, and that function is recited in Claim 1.

Of particular note is the fact that three Aces (which would have three replacement cards in the game of Dahl, or four replacement cards if the 4-of-

Clubs is present) is always paid the same amount, whether there are 3 or 4 replacement cards present. When the player hand is Four Aces (which would have at least four replacement cards) is paid, the payment is for the rank of the hand. It is only when all five replacement cards (e.g., the four Aces and the 4-of-Clubs) are present is there any differentiation from the payment on a hand of Four Aces.

As can be seen from the pay table of Dahl, there is no side bet payment:

“...if at least one of the displayed player’s cards is a replacement card, paying a player who has placed the optional wager for the presence of the at least one replacement card in either the player’s hand or the dealer’s hand.”

Parsing the limitation down to make it easier to determine the lack of limits, it can be seen that Dahl does not base a resolution on:

“...if at least one of the displayed player’s cards is a replacement card,...”

does not pay a player:

“...for the presence of the at least one replacement card...”

and does not pay a player for the presence of at least one replacement card:

“...in either the player’s hand or the dealer’s hand...”

As can be seen from this detailed analysis of these limitations, Dahl does not anticipate the claimed invention. Dahl teaches an optional side bet based upon the appearance of specific hands, not upon the appearance of “at least one...replacement card.” The rejection is in error.

2) Claim 6 has been rejected under 35 USC 103(a) as unpatentable over Dahl (above).

This claim contains the same limitation as does claim 1 that were discussed above as at least one basis for evidencing that Dahl does not anticipate the present invention. As there is also no basis for asserting that the subject matter was obvious from the disclosure of Dahl, the rejection of claim 6 under 35 USC 103(a) must also fail for at least that reason.

- 3) Claims 10, 16 and 17 have been rejected under 35 USC 103(a) as unpatentable over the Ten Stix® 21 game.

The rejection asserts that:

- a) Ten Stix® 21 game is a variant of the game Twenty-One with six standard decks of cards. There is at least one specially marked card, a “10” with the Ten Stix® game logo on it in each deck, so that there are, for example, six specially marked cards in a six deck shoe. Upon receiving a specially marked “10” card, the player may:
 - i) keep the “10” card and play it as a value of 10 in the hand
 - ii) turn in the “10” card, receive the next card from the shoe, and a light will indicate the card has been traded.
 - iii) The bonus card cannot be turned in to salvage a bust based on the value of 10.
 - iv) After ten ‘lights’ have been collected, the player may activate a random prize selector.

As can be seen from the description provided in the publication of the game TenStix® 21 game, the benefit of having the specially marked card is either or both a) being able to replace a card and/or b) collecting light indicators that may accumulate from game to game to a level that may be traded in for a random prize. Claim 10 is believed to have been amended to clearly exclude this line of play. Amended claim 10 recites:

“10. (CURRENTLY AMENDED) A method of providing a wagering game over at least two time periods comprising:
playing over a first time period a casino table wagering game using symbols in the play of the wagering game wherein **a first payout table is used with a payout bonus provided for players having at least one specially marked symbol that displays standard count value in the casino table wagering game**, the first time period using a first number of specially marked symbols in the play of the game, and
subsequently to playing the table wagering game over the first time period, playing the casino table wagering game over a second time period with a second number of specially marked symbols that display standard count value in the play of the game, the second number being different from the first number.”

The claim requires that there be a payout table for use with the specially marked cards (Ten Stix® 21 game does not have a pay table) and in the Ten Six® 21 game there are no direct payout bonuses for the appearance of the specially marked cards (lights are accumulated that have no payout value, but may be collected in a session to get a random, not a pay table, award).

There is no basis for asserting that these differences are obvious from the teachings of the Ten Stix® 21 game alone.

4) Claims 11, 15 and 18-21 have been rejected under 35 USC 112, second paragraph.

These claims have been amended and the objectionable language has been removed or replaced.

5) Claims 11, 15 and 18-21 have been indicated as allowable if the issues under 35 USC 112, are resolved.

These claims have been amended and the objectionable language has been removed or replaced. The claims are now allowable.

6) Claims 4, 5, 7-9, 12-14, 22-24 and 26-28 have been indicated as allowable if placed into independent form, with all intervening limitations.

These claims have been amended so that the claims are either in independent form or now depend from a claim that should be allowable within this original group of claims.

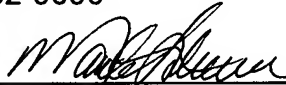
CONCLUSION

All claims are now believed to be in condition for allowance. The Examiner is respectfully requested to call the attorney of record at **952.832.9090** to discuss any minor issues that could be resolved in a telephone interview.

Respectfully submitted,
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CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this Transmittal Letter and the paper, as described herein, are being deposited in the United States Postal Service, as first class mail, with sufficient postage, in an envelope addressed to: Mail Stop: AMENDMENT, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 on AUGUST 12, 2004.

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